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| 10/673,207  | 09/30/2003  | Hyung-Jong Kang      | 101-1004                    | 9591                   |
| 38209 7590 12/10/2008<br>STANZIONE & KIM, LLP<br>919 18TH STREET, N.W.<br>SUITE 440<br>WASHINGTON, DC 20006 |             |                      | EXAMINER<br>SARPONG, AKWASI |                        |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/673,207

**Applicant(s)**

KANG ET AL.

**Examiner**

AKWASI M. SARPONG

**Art Unit**

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 39-41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 and 39 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/27/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-13 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roosen (20020027673) in view of Shaw (6151598) .

**Claim 1**, Roosen discloses a scanning and/or printing apparatus (**Section 0062, Fig. 1 shows apparatus 1 that can be used for scanning and printing**) comprising:  
a scanning unit (**scanner unit 3**) scanning a document and outputting a scanned result (**Section 0063, lines 1-6-hence the generated scanned image data (scanned result) is stored into memory 4**).

a storage unit (**memory 4**) storing the scanned result inputted from the scanning unit (**Section 0063, Fig. 2, El. 4- thus Memory 4 stores the generated image data (scanned result) and**

a printing unit (**Fig. 2, El. 5 or Printer 5**) reading the scanned result from the storage unit (**Memory 4**) to print the scanned result (**Section 0063-thus the generated image data is read out from memory 4 to be printed by Printer 5**).

Roosen does not disclose wherein the storage unit is selectively connected to one of the scanning unit and the printing unit.

Shaw discloses wherein the storage unit is selectively connected to one of the scanning unit and the printing unit. **(Col. 8 Lines 7-15, Fig. 6 El. 158 or scanner 185 or printer 154-thus document entry 503 are used so that the user can selectively connect the storage 509 to either the scanner 158 or printer 154 as clearly disclosed in Col. 7 Lines 30-35).** Therefore it will be obvious to one ordinary skilled in the art at the time the invention was made, to modify Roosen's apparatus 1 to include Shaw's document entry 503 so that the user can use that as a means to selectively connect storage 509 to either scanner 158 or printer 154 in order to give the user some option or some free room to operate as to which unit he wants to connect to.

**NB: understand that as document entry 509 is included in apparatus 1 in Roosen the user can selectively connect storage or memory 4 to either scanner 4 so that image scanned can be stored into memory 4 and after that can be connected to printer 5 in order for the stored image data to be taking out for printing.**

**Claim 2, Roosen in view of Shaw discloses wherein a first connector (Roosen: Fig. 2 El, 2- thus the arrow between scanner 3 and memory set 4 shows that there is a connector between the two device) connecting the storage unit (Roosen : Memory 4) to the scanning unit (Roosen: scanner 3) and a second connector (Roosen: Fig. 2 El, 2- thus the arrow between printer 5 and memory set 4 shows that there is a connector between the two device) connecting the storage unit to the printing unit. (NB: Understand that the arrows shown in fig. 2 indicate connection**

**between the various components with in apparatus 1 as it is clearly discussed in Section 0075) .**

**Claim 3, Roosen in view of Shaw discloses wherein the scanning unit (Roosen: Fig. 2, El. 3 or Scanner 3) comprises an input/output port (NB: again Understand that where the arrows connects with the component indicates a port wherein data can be transferred back and forth as it discussed clearly in Section 0075) and a scanning control unit (Roosen: Fig. 2, El. 26 or scan handler 26) outputting the scanned result to the storage unit through the input/output port and the first connector. (Roosen: Section 0071- thus the scan handler also referred to as control unit is dedicated for providing scanning processes and as discussed earlier the arrow line indicates how the various components are connected).**

**Claim 4, Roosen in view of Shaw discloses wherein the scanning unit further comprises a display unit (Roosen: Fig. 4 or display component 4 ) displaying the scanned result (Roosen: Section 0096-thus display screen shows the file names of image data that is available to be printed after it has been scanned) and a key unit (Fig. 4 El. 64 (A-E) and (65 (A-D) shows keys on the operator panel) generating at least one of a searching signal, a deleting signal, (Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job, therefore that key generates a deleting signal to coarse the control unit to delete the print**

**job)** and a selecting signal, **(Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus)**

and the scanning control unit **(Roosen: Scan handler 26)** scrolls the scanned result displayed on the display unit according to the searching signal of the key unit, **(Roosen: Section 0095, Fig. 4 El. 66A and B- thus keys 66A and B are used for scrolling back and forth in looking for a particular file to be printed)** deletes the scanned result according to the deleting signal of the key unit, **(Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job, therefore that key generates a deleting signal to coarse the control unit to delete the print job)** selects the scanned result according to the selecting signal of the key unit, **(Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus)**

and generates a control signal to control the display unit to display the scanned result. **(Roosen: Section 0096- thus display screen shows the file names of image data that is available to be printed after it has been scanned).**

**Claim 5**, Roosen in view of Shaw discloses wherein the printing unit comprises: an input/output port **(NB: again Understand that where the arrows connects with the component indicates a port wherein data can be transferred back and forth as it is discussed clearly in Section 0075)** and a printing control unit **(Roosen: Fig. 2, El. 25, or print handler)** reading the scanned result inputted from the storage unit through the input/output port **(Roosen: Section 0063, lines 1-9- thus the scanned or**

**generated image data is read from memory 4 by printer 5 ) and the second connector to print the scanned result. (NB: Understand that the arrows shown in fig. 2 indicate connection between the various components with in apparatus 1 as it is clearly discussed in Section 0075) .**

**Claim 6, Roosen in view of Shaw discloses wherein the printing unit further comprises a display unit (Roosen: Fig. 4 or display component 4 ) displaying the scanned result read from the storage unit and inputted through the input/output port (Roosen: Section 0096-thus display screen shows the file names of image data that is available to be printed after it has been scanned) and a key unit generating at least one of a searching signal, a deleting signal, (Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job, therefore that key generates a deleting signal to coarse the control unit to delete the print job) and a selecting signal, (Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus)**

and

the printing control unit (Roosen: Print handler 25) scrolls the scanned result displayed on the second display unit according to the searching signal of the key unit, (Roosen: Section 0095, Fig. 4 El. 66A and B- thus keys 66A and B are used for scrolling back and forth in looking for a particular file to be printed) deletes the scanned result according to the deleting signal of the key unit, (Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job,

**therefore that key generates a deleting signal to coarse the control unit to delete the print job)** selects the scanned result according to the selecting signal of the key unit, **(Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus)** and generates a control signal to control the display unit to display the scanned result. **(Roosen: Section 0096-thus display screen shows the file names of image data that is available to be printed after it has been scanned).**

**Claim 8** Roosen in view Shaw discloses a method of a scanning and/or printing apparatus **(Roosen: Section 0062, Fig. 1 shows apparatus 1 that can be used for scanning and printing)**, the method comprising causing a storage unit **(Roosen: memory 4)** to be connected to a scanning unit **(Roosen: scanner unit 3)** scanning a document and outputting a scanned result. **(Roosen: Section 0063, lines 1-6-hence the generated scanned image data (scanned result) is stored into memory 4).**

storing the scanned result inputted from the scanning unit into the storage unit. **(Roosen: Section 0063, Fig. 2, El. 4- thus Memory 4 stores the generated image data (scanned result)**

causing the storage unit to be directly connected to a printing unit reading the scanned result from the storage unit. **(Roosen: Section 0063-thus the generated image data is read out from memory 4 to be printed by Printer 5).**



and printing the scanned result read from the storage unit in the printing unit.

**(Roosen: Section 0063- the image data is printed out by printer 5 after it has been read out from memory 4)**

**Claim 9, Roosen in view of Shaw discloses a scanning and/or printing apparatus (Section 0062, Fig. 1 shows apparatus 1 that can be used for scanning and printing), comprising: a scanning and/or printing unit (apparatus 1 has scanner 3 and printer 5 as clearly shown in Fig. 2) scanning a document and printing the scanned result (Section 0063-thus scanner 3 scans the image placed on the flatten and stores the image data in memory 4) and a storage unit (Storage unit 20 and memory 4 are storage units for storing scanned or generated images) shown in storing the scanned result inputted from the scanning and/or printing unit (Apparatus 1 has a scanning and printing unit) and (Section 0063-thus the generated image data is read out from memory 4 to be printed by Printer 5) wherein the scanning and/or printing unit prints the scanned result read from the storage units. (Section 0063-thus printer 5 after the image data has been scanned and stored in memory 4, prints the image data).**

Roosen does not disclose a plurality of storage units which can be connected to apparatus 1.

Shaw discloses a plurality of storage units **(external document storage 503)** which can be connected to apparatus 1. **(Col. 8 Lines 8-15-thus with the document**

**entry 503, a plurality of external storage units can be connected to apparatus).**

Therefore it will be obvious to one ordinary skilled in the art at the time the invention was made, to modify Roosen's apparatus with Shaw's document entry 503 which will make it possible for a plurality of storage unit or devices to be connected as clearly taught by Shaw in Col. 9, lines 11-20.

**Claim 10**, Roosen in view of Shaw discloses wherein the scanning and/or printing unit **(Roosen: apparatus 1 includes both a scanning and a printing unit)** comprises a plurality of connectors connecting corresponding ones of the storage units to the scanning and/or printing unit. **(Shaw: Col. 8, lines 8-15- understand that for the document entry 503 to make it possible for a plurality of external storage to be connected to the document processing device there should be a plurality of connectors).**

**Claim 11**, Roosen in view of Shaw discloses wherein the scanning and/or printing unit **(Roosen: Fig. 2, El. 3 or Scanner 3)** further comprises  
an input/output port **(Roosen: NB: again Understand that where the arrows connects with the component indicates a port wherein data can be transferred back and forth as it discussed clearly in Section 0075)** and a scanning/printing control unit **(Roosen: Fig. 2 El. 6 or copy controller)** outputting the scanned result to the storage units through the input/output port and corresponding ones of the

connectors, **(Roosen: Section 0071- thus the copy controller also referred to as control unit is dedicated for providing scanning and printing processes and as discussed earlier the arrow line indicates how the various components are connected).**

and printing the scanned result inputted from the storage units through the input/output port and the corresponding ones of the connectors. **(Roosen: Section 0063- the scanned image data is printed by printer-5)**

**Claim 12**, Roosen in view of Shaw discloses wherein the scanning and/or printing control unit further comprises a display unit ( **Roosen: Fig. 4 or display component 4** ) displaying the scanned result scanned from the document and read and inputted from the storage units through the input/output port, **(Roosen: Section 0096- thus display screen shows the file names of image data that is available to be printed after it has been scanned)**

and a key unit generating at least one of a searching signal, a deleting signal, **(Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job, therefore that key generates a deleting signal to coarse the control unit to delete the print job)**and a selecting signal, **(Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus)**

and the scanning control unit scrolls the scanned result displayed on the display unit according to the searching signal of the key unit, **(Roosen: Section 0095, Fig. 4 El. 66A and B- thus keys 66A and B are used for scrolling back and forth in looking**

**for a particular file to be printed)** deletes the scanned result according to the deleting signal of the key unit, **(Roosen: Section 0228, lines 1-10, thus key 64C is used for aborting or cancelling or deleting a print job, therefore that key generates a deleting signal to coarse the control unit to delete the print job)** selects the scanned result according to the selecting signal of the key unit, **(Roosen: Section 0087, Lines 1-8, thus keys 64 A-E are used for selecting a function within apparatus).**

and generates a first control signal to control the display unit to display the scanned result scanned from the document **(Roosen: Section 0096-thus display screen shows the file names of image data that is available to be printed after it has been scanned)** and a second control signal to control the display unit to display the scanned result and inputted from the storage units through the input/output port. **(Roosen: Section 0096-thus display screen shows the file names of image data that is available to be printed after it has been scanned).**

**NB: Understand that the scanned result scanned from the document is the same as the scanned result stored in the memory 4 since document scanned are stored into memory 4.**

**Claim 13**, Roosen in view of Shaw discloses a method of a scanning and/or printing apparatus, the method comprising scanning a document in a scanning and/or printing unit **(Roosen: Section 0063-thus the scanning unit is used for scanning images or documents placed on the platen)** storing a scanned result in a plurality of

storage units; **(Roosen: Section 0063 thus the generated image data is stored into memory-4)** reading the scanned result from the storage units and printing the scanned result read from the storage unit. **(Roosen: Section 0063: thus the stored data is eventually read or retrieved by printer-5 and printed).**

**Claim 39**, Roosen in view of Shaw discloses a scanning and printing apparatus, comprising a main body **(Roosen: Fig. 1 shows the main body of apparatus 1)** a scanning unit disposed in the main body scanning a document to output a scanned result, **(Roosen: Section 0063, Fig. 2 el. 3 shows a scanner 3 which is in apparatus 1)** a printing unit disposed in the main body printing the scanned result; **(Roosen: Section 0063, Fig. 2 El. 5 shows a scanner 3 which is in apparatus 1)** and a storage unit **(Roosen: Memory-4)** selectively connected to one of the scanning unit and the printing unit, **(Shaw: Col. 8 Lines 7-15-thus document entry 503 can used in apparatus 1 so that the user can select the scanner or printer to connect the storage).**

**Claim 40**, Roosen in view of Shaw discloses wherein the storage unit is directly attached to the scanning unit without interference of a processing unit disposed outside of the scanning and printing apparatus. **(Roosen: Section 0063-thus Memory 4 is directly attached to scanner 3 and printer 5).**

**Claim 41**, Roosen in view of Shaw discloses wherein the storage unit is detachably connected to the main body. **(Shaw: Col. 8 lines 8-15-thus storage 509 is an external device then it can be detached).**

.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roosen (20020027673) in view of Shaw (6151598) and further in view of Chen (7019869)

**Claim 7, Roosen in view of Shaw does not disclose** wherein the storage unit comprises a universal serial bus (USB) flash memory stick.

Chen discloses wherein the storage unit comprises a universal serial bus (USB) flash memory stick. **(Col. 6 lines 4-10, Fig. 4, El. 471 and 481- thus El. 471 and 481 shows a USB interface).** Therefore it will be obvious to one ordinary skilled in the art, at the time the invention was made to modify Roosen's in view of Shaw's memory 4 with Chen's USB interface so that any serial bus adapted device can be used by the apparatus.

**Response to applicant's argument:**

**Response to applicant's remarks on restriction requirement.**

The applicant's response filed on 01/09/2008 towards restriction requirement was considered but was not persuasive.

Applicant argues that the Examiner fails to prove that the claims are (A) a separate classification for the alleged several inventions, (B) a separate status in the art when they are classifiable together, or (C) a different field of search. See MPEP § 808.02. and therefore the restriction must be reversed.

In reply the examiner disagrees because it is clear under MPEP 806.05 that distinct claimed inventions are to be restricted. The invention as claimed is distinct because of the following reasons:

Species 1 of FIGS. 2-4 corresponding to claims 1-13 and 39-40, these claims corresponds to a scanning and or printing apparatus meaning it can be an apparatus with a scanner and a printer combined which can be a photocopier or as well known in the art an MFP. It is evidently clear that a copier or an MFP are distinctly different from a standalone printer or scanner and therefore searching for this apparatus will be in a different sub class under a broad class of 358 such as 1.15 since there is a communication between the printing and scanning section of apparatus as shown in Fig. 3

Species 2 of FIGS. 1A, 2, and 5-7 corresponding to claims 14-32 these claims also corresponds to a scanning apparatus. It is clear that a scanning apparatus is absolutely distinct from a copier or Multi functional peripheral equipment. Therefore these are distinct inventions and the restriction requirement is maintained. Further the

scanning limitation has to be searched in Class 358/474 and 505 and therefore puts an additional burden on the examiner during prosecution.

- Species 3 of FIGS. 1B and 2 corresponding to claims 33-38. These claims also correspond to a printing apparatus and It is clear that a printing apparatus is absolutely distinct from a copier or Multi functional peripheral equipment or a scanning apparatus alone. Therefore a printing apparatus is absolutely distinct from a scanning apparatus and a copier or multi peripheral equipment and the restriction requirement is maintained. Moreover since this species corresponds to a printer or image reproduction a search has to be done in Class 358/501 and 401. Also the search term memory and Page of memory has to be search for in Class and subclass 358/1.17 and therefore also impose an additional burden on the Examiner during prosecution.

#### **New grounds of rejection.**

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AKWASI M. SARPONG whose telephone number is (571)270-3438. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm est.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

AMS

